

## REMARKS

Applicants respectfully request reconsideration of this application, and reconsideration of the Office Action dated April 22, 2005. Upon entry of this Amendment, claims 1, 3, 4, and 7-18 will remain pending in this application. Claims 2, 5, and 6 were canceled via the Amendment filed July 21, 2004. Claims 7 and 10 have each been amended to correct an antecedent basis issue. In addition, claims 14 and 15 are amended to ensure they do not depend from canceled claims 2, 5, or 6. No new matter is introduced as a result of this Amendment.

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Claims 1, 3, 4, 7-13, and 16-18 are rejected under 35 U.S.C. § 102(b) as purportedly anticipated by Shimazaki (U.S. Pat. No. 6,160,950). The Office Action asserts Shimazaki describes each feature of the claims and thus anticipates the claimed invention. Applicants respectfully traverse.

As an initial matter, Applicants respectfully submit that Shimazaki (1) is owned by the same assignee-owner of the present application, and (2) is not prior art under 35 U.S.C. 102(b). The present application has a U.S. filing date of October 20, 2000. The Shimazaki patent did not issue until after such filing date, on December 12, 2000. Hence, Shimazaki does not qualify as prior art under 35 U.S.C. 102(b) but rather under § 102(e).

Independent claim 1 concerns a data recording apparatus that sequentially inputs data configured in units that cannot be recorded across different files and records the data in a file having a predetermined volume. The apparatus includes a size detecting means for deciding, when data is sequentially recorded in file, whether the next unit of the data to be recorded can be fully recorded in the same file, or not. The apparatus also includes a file creation controlling means for recording the next data to be recorded in another file, or

halting recording where the result of the decision by the size detecting means is that recording is not possible. Further, claim 1 recites a file writing means for writing data in a file according to the control from the file creation controlling means.

Shimazaki discloses an apparatus for reproducing only essential portions of an entered or recorded program in a digest form after recording the AV data of such a program. See Abstract and Column 1, Line 55 to Column 2, Line 23. The Office Action asserts the record control means 7 disclosed in Shimazaki corresponds to the file creation control means feature of claim 1. However, Shimizaki's record control means only rewinds a tape and sequentially records address data. In other words, the record control means processes address data; it does not change the file to record the data to another file. Hence, Shimizaki fails to teach or fairly describe each and every feature of claim 1, and thus cannot be said to anticipate claim 1.

The apparatus of independent claim 3 (from which claim 17 depends) includes an image mode information detecting means for detecting a change of image mode information attached to the data, and a file recording controlling means for controlling the recording of the data to the file. When a change in content of the image mode information is detected by the image mode information detecting means, the file recording controlling means changes the file to record the data to another file, and sequentially records the data, or stops recording. As discussed above, the record control means of Shimazaki's apparatus does not change the file to record the data to another file. Hence, Shimazaki fails to teach or fairly suggest a file recording controlling means that changes the file to record data to another file, and then sequentially records the data, or stops recording. Shimizaki thus also fails to teach or fairly describe each and every feature of claim 3 and thus cannot anticipate claim 3.

Like claim 3, the apparatus of independent claim 4 (from which claim 18 depends) includes the feature wherein when a change in content of the image mode information is detected by the image mode information detecting means, the file recording controlling means changes the file to record the data to another file and sequentially records the data or stops recording. Hence, for at least the same reason discussed above with respect to claim 3, Shimazaki also fails to anticipate claim 4.

The apparatuses of independent claim 7 (from which claims 8 and 9 depend) and independent claim 10 (from which claims 11 and 12 depend) both include a file recording controlling means for converting the property of the data to the previous property and recording data in the file when the detecting means detects a change of the property. These claims each go on to recite a file writing means for writing data in a file according to control from the file recording controlling means. Shimizaki fails to teach or fairly suggest a file recording controlling means that writes data in a file to control from a file recording controlling means. Hence, Shimizaki fails to teach each and every feature of claims 7 and 10 and thus also cannot anticipate these claims.

The apparatus of independent claim 13, like claim 1, includes a file creation controlling means for recording next data to be recorded in another file or stopping recording where the result of the decision by the size detecting means is that recording is not possible. Hence, for the reasons discussed above with respect to claim 1, Shimizaki fails to teach or fairly suggest every feature of claim 13, and thus cannot anticipate claim 13.

The apparatus of independent claim 16 includes the feature wherein when the volume of data stored in the file detected by the size detecting means exceeds a predetermined volume, the file recording control means changes the file to record the data

to another file, and sequentially records the data, or stops recording. Again, this feature is neither taught nor fairly suggested by Shimazaki. Shimazaki thus cannot anticipate claim 16.

In view of the above remarks, Applicants respectfully submit this rejection is overcome and thus request it be withdrawn.

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Claims 14 and 15 are rejected under 35 U.S.C. § 103(a) as purportedly obvious based on Shimazaki in view of Itoh (U.S. Pat. No. 6,700,989). Applicants also respectfully traverse this rejection.

Applicants submit that 35 U.S.C. § 103(c) states:

**(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. M.P.E.P 706.02(I)(1).**

As noted above, the Shimazaki patent publication qualifies as prior art under 35 U.S.C. § 102(e), not § 102(b). Shimazaki therefore hereby is disqualified as prior art under 35 U.S.C. § 103(c). This U.S. Application No. 09/692,312 and U.S. Patent No. 6,160,950 to Shimazaki were, at the time the invention of this U.S. Application No. 09/692,312 was made, owned by Matsushita Electric Industrial Co., Ltd. In view of the foregoing, withdrawal of the rejection is respectfully requested.

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Applicants respectfully submit this Amendment and the above remarks obviate the outstanding rejections in this case, thereby placing the application in condition for immediate allowance. Allowance of this application is earnestly solicited.

If any fees under 37 C.F.R. §§ 1.16 or 1.17 are due in connection with this filing, please charge the fees to Deposit Account No. 02-4300; Order No. 033216.059.

If an extension of time under 37 C.F.R. § 1.136 is necessary that is not accounted for in the papers filed herewith, such an extension is requested. The extension fee should be charged to Deposit Account No. 02-4300; Order No. 033216.059.

Respectfully submitted,  
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